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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,611	11/10/2003	Ray C. Smith	004222 UID1 USA	4703
20558	7590	12/10/2004	EXAMINER	
KONNEKER & SMITH P. C. 660 NORTH CENTRAL EXPRESSWAY SUITE 230 PLANO, TX 75074			TSAY, FRANK	
			ART UNIT	PAPER NUMBER
			3672	

DATE MAILED: 12/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/705,611	SMITH, RAY C.
	Examiner	Art Unit
	Frank S Tsay	3672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 10 November 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-67 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 40-46 is/are allowed.
- 6) Claim(s) 1-6,8,9,14,15,19,29-33,37-39,47-49,51,52,54,59-63,66 and 67 is/are rejected.
- 7) Claim(s) 7,10-13,16-18,20-28,34-36,50,53,55-58,64 and 65 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 10 November 2003 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/29/03</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 8, 9, 14, 15, 19, 29-33, 37-39, 47-49, 51, 52, 54, 59-63, 66 and 67 are rejected under 35 U.S.C. 102(b) as being Anticipated by Gano et al (US 6,135,208). Gano et al discloses a method of anchoring an expandable well bore connector in a well which comprises all of the claimed structure and method of using the same, which includes positioning a tubular or casing string 282, 322 (Figs 7, 10) which may then be cemented. As seen in Fig. 10, a latching structure 294 having upper and lower recesses 296 is conveyed into the tubular or casing string to form the latching profiles by setting the latching structure inside the tubular string for service tool 326. The steps of expanding the latch profile and plastically deforming the tubular string is clearly anticipated by Figs 7-10, and col. 16, line 5-col. 18, line 33. The wedge structure is met by swage 288; the at least one recess on the interior surface of tubular string is clearly shown in Fig. 10 near reference numerals 274b, 272b as well as Fig. 6B near numeral 174. The material of seals is clearly anticipated by col. 16, lines 47-60, as it is well understood that a metal to metal seal between two tubular surfaces is commonly known to one of the ordinary skill in the art. The dimensional relationship between the internal dimension of the profile and the internal dimension of the tubular string is clearly

anticipated in Figs. 7-10, where the internal diameter of latch profile could either be equal, smaller or greater than the minimum internal diameter of the tubular string during different stages of operation.

The language "bonding the expandable structure to the tubular string" fails to distinguish from the tight gripping force generated by the grip member 276 upon expansion of expandable tubular 292 shown in Fig. 10. The step of conveying a whipstock is met by Figs 1C and 4A where a whipstock or deflection member 48 is conveyed prior to the step of forming.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 29-33, 37-39 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 24-31 of prior U.S. Patent No. 6,808,022. This is a double patenting rejection.

Allowable Subject Matter

Claims 7, 10-13, 16-18, 20-28, 34-36, 50, 53, 55-58, 64 and 65 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in

independent form including all of the limitations of the base claim and any intervening claims.

Claims 40-46 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank S Tsay whose telephone number is (703) 308-2170. The examiner can normally be reached on Monday thru Friday, 7:30am-5:00 pm, 2nd Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J Bagnell can be reached on (703)308-2151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Frank S Tsay
Primary Examiner
Art Unit 3672

12/07/04